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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,243	06/22/1999	SCOTT D. MAURER	117077-4	8744

21324 7590 07/14/2003  
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EXAMINER

SAFAVI, MICHAEL

ART UNIT	PAPER NUMBER
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3673

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DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/337,243

Applicant(s)

MAURER, SCOTT D.

Examiner

M. Safavi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 85-93 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 85-93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 91 and 92 been renumbered as claims 92 and 93, respectively.

***Information Disclosure Statement***

2. Applicant's remarks with respect to Outwater 1999-A Master Catalog have been reviewed. However, Applicant's allegation or admission that "the flexible molding described in the pages attached to the information disclosure statement "is prior art to Applicant's invention" does not appear adequate to establish a publication date sufficient to determine the applicability of a rejection based upon the Outwater 1999-A Master Catalog.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 93 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

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in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear to disclose a substantially flat foam member, installed or uninstalled. Such would appear as new matter.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 93 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 93, it is not understood as to what is being defined by "...is substantially flat from the first...edge to the second...edge when installed...". The specification does not appear to clearly present such a configuration.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 85 and 88-91, and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckel et al. in view of Johnson.

Eckel et al. discloses, Fig. 2, a monolithic plastic molding having front side and rear side with a first layer of pressure sensitive adhesive along a first edge of the rear side and a second layer of pressure sensitive adhesive along a second edge of the rear side. A central portion of the molding extends between the first layer of pressure sensitive adhesive and the second layer of pressure sensitive adhesive. The second layer of adhesive can be seen as oriented about perpendicular to the first layer of adhesive with the central portion being the majority of the plastic member rear side.

Johnson discloses a molding 12 or 12/16/17 formed of a foam material with the molding possessing adhesive strips 19 along edges of a rear side thereof and a decorative surface, col. 4, lines 60-62. Release material for the adhesive strips is shown at 20. Johnson teaches forming the molding of at least 1/16 inch with the entire molding including layer 12 being on the order of at least 3/16 inch, (layer 12 being taught as not as thin as layer 17, 18).

To have formed the Eckel et al. molding of a closed cell foam, including a polyethylene foam having a thickness of at least 3/16 inch, thus providing a light weight molding with sufficient cushioning properties, would have constituted an obvious expedient to one having ordinary skill in the art as taught by Johnson. To have formed the resulting Eckel et al. molding in lengths of at least 120 feet, thus producing a molding stock length as necessary, would have

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constituted a further obvious expedient to one having ordinary skill in the art. Such a stock of molding would be capable of being stored in a roll form with a diameter of 30 inches.

9. Claims 86 and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckel et al. in view of Johnson as applied to claims 85 and 88-91 above, and further in view of either of Hayashi et al. or Johnson et al.

Each of Hayashi et al. and Johnson et al. teaches application of corona primer treatment to a foam member so as to enhance adhesion of any adjoining layer. To have pre-primed or corona treated the modified Eckel et al. molding, thus enhancing adhesion of any adjoining layer such as the adhesive layer 2, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made in view of either of Hayashi et al. or Johnson et al.

10. Claims 88 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckel et al. in view of Johnson as applied to claims 85 and 88-91 above, and further in view of either of Hamlin or Morris et al.

Each of Hamlin and Morris et al. teach application of roll forming to a flexible building stock material so as to allow for ease of handling and delivery. To have formed or packaged the modified Eckel et al. foam molding member in a roll, thus permitting ease of handling and delivery, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made in view of either of Hamlin or Morris et al. To have formed the

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resulting Eckel et al. molding in lengths of at least 120 feet, thus producing a molding stock length as necessary, would have constituted a further obvious expedient to one having ordinary skill in the art. Such a stock of molding would be capable of being stored in a roll form with a diameter of 30 inches.

11. Claim 92 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eckel et al. in view of Johnson as applied to claims 85 and 88-91 above, and further in view of Freeman.

Freeman discloses a building stock material formed of a foam material having a density of from about 1 to about 25 pounds per cubic foot, col. 2, lines 7-9. To have formed the modified Eckel et al. member 1 of a foam having a density of less than 9 lbs./cu. ft., thus providing a member which would allow for ease of handling and placement, would have constituted a further obvious expedient to one of ordinary skill in the art as taught by Freeman.

***Response to Arguments***

12. Applicant's arguments with respect to claims 85-93 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.



**MICHAEL SAFAVI**  
**PRIMARY EXAMINER**  
**ART UNIT 364**

M. Safavi  
July 10, 2003